



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/428,458 10/28/99 TASHEN

K Q-56244

HM12/0828
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EXAMINER

SCHMIDT, M

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/428,458

Applicant(s)

TASKEN ET AL.

Examiner

Mary Schmidt

Art Unit

1635

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 22-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

KATRINA TURNER
PATENT ANALYST

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 22, 24, 35 and 38-39, drawn to pharmaceutical compositions and methods of inhibiting the effects mediated by PKA type Ialpha isozyme via use of a cAMP antagonist, classifiable in class 514, subclass 46.
- II. Claims 22, 25-27, 35-36, and 38-39, drawn to pharmaceutical compositions and methods of inhibiting the effects mediated by PKA type Ialpha isozyme using a ribozyme and ribozyme compositions, classifiable in classes 514 and 536, subclasses 44 and 24.5 respectively.
- III. Claims 22, 28-29, 35, 37-39, drawn to pharmaceutical compositions and methods of inhibiting the effects mediated by PKA type Ialpha isozyme using an antisense and antisense compositions, classifiable in classes 514 and 536, subclasses 44 and 24.5 respectively.
- IV. Claims 22, 30-35 and 38-39, drawn to pharmaceutical compositions and methods of inhibiting the effects mediated by PKA type Ialpha isozyme using a peptide, classifiable in class 514, subclass 2.
- V. Claims 22-23, 35 and 39-39, drawn to pharmaceutical compositions and methods of using a cAMP analog, classifiable in class 514, subclass 46.

Note upon election of one of the above Groups, the generic claims will only be examined to the extent of the species specified in that Group.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV and V are unrelated from each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Each of the above Groups has a different active ingredient composition: Group (1), a cAMP antagonist; Group (2), a ribozyme; Group (3), an antisense; Group (4), a peptide; Group (5), a cAMP analog. The scientific properties, ie. the physical and chemical structure of each active ingredient differs in the art. For instance an antisense is typically a short, oligonucleotide which binds to a target mRNA for inhibition of the gene expression via RNase H; a ribozyme is typically an RNA which has a sequence that binds the target sequence and cleaves the target; a peptide is comprised of amino acids which would function to inhibit a receptor binding site; an analog does not act to bind a target, but instead acts by filling the role of the non-modified cAMP in an inhibitory manner; and the cAMP antagonist acts to block the cAMP function as well. Each such composition functions differently based on the physical and chemical structures and thus require a separate search in the art.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Groups I, II, III, IV or V is not required for any of the other Groups, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary M. Schmidt whose telephone number is (703) 308-4471. The examiner can normally be reached on Monday-Friday 9:00 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-5264 for regular communications and (703) 746-5264 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3413.


ANDREW WANG
PRIMARY EXAMINER